

Page 103, line 2: before "powder" insert --a--.

REMARKS

It has been noted by Applicants that the Examiner, after having issued an Action on the merits of all the claims (Paper No. 2) which elicited a response amending a number of claims (Paper No. 4), has now required restriction in a second Action which treats none of the claims on the merits and does not discuss the Response to the first Action. It is respectfully submitted that this procedure is, to say the least, unusual.

The restriction requirement is respectfully traversed.

The Examiner said that upon reconsideration "it is clear that this application is drawn to two separate and distinct concepts" (emphasis added in part) and he required restriction to one of the "concepts" citing 35 U.S.C. 121 as authority for this requirement. 35 U.S.C. 121 states that the Commissioner may require an application to be restricted to one of a number of inventions, not concepts, if two or more independent and distinct inventions are claimed in one application. Thus, it is unclear why the Examiner required restriction without contending that there are a number of independent and distinct inventions.

Furthermore, it is noted that the Examiner denoted the two "concepts" as the compounds and the process of making the compounds without denoting which claims are involved and what classification he considers them to fall in. As for the former, it is clear that the compounds are covered by claims 1 - 7 and 11 - 12 while the process for making the compounds is covered in claims 8 - 10. As for the latter, it is respectfully submitted that they all fall within the same class and subclass.

It is additionally respectfully submitted that the Examiner's own actions are proof that the compounds and the process for making the compounds are involved in the same field of search, as witness the fact that the Examiner conducted a search and rendered an action on the merits of all the claims using the same prior art to reject all the claims, although the rejection was proven faulty in the Response to the first Action.

It is pointed out, incidentally, that since the Examiner has not seen fit to respond to the Amendment which was filed May 25, 1979, it is presumed that he agrees with all the comments made therein.

The Examiner said that each of the two groups of "concepts" will support separate patents, that each group is separately searched, and that each group requires separate and distinct considerations for patentability. He then stated that the burden falls on Applicants to disprove his assertions citing In re Young 81 USPQ 139 (CCPA 1949). In fact, this decision, at page 142, says that burden is on the Applicants to disprove factual assertions made by the Examiner. The first assertion, that each group will support separate patents, is conclusory and not factual. It is simply is not true. The second statement that each group is separately searched has already been disproved since the Examiner searched both groups at the same time and rendered an Action on the merits concerning both groups. As for the third assertion, that each group requires separate and distinct considerations for patentability, the Examiner's attention is respectfully directed to 35 U.S.C. 102, 35 U.S.C. 103, and 35 U.S.C. 112. The same considerations for patentability apply to all inventions under these cited sections of the 1952 Patent Act.

If the Examiner considers these requirements of the statute not to apply equally to all inventions, he is respectfully requested to cite his authority.

The Examiner said that the compounds of Group A may be prepared by other than the process of Group B, but has not cited any authority for this sweeping statement. In fact, there is one invention involved in this application, and one invention only. At the risk of seeming repetitious, the Examiner has proven this point by examining all the claims on the merits in the first Action without evidencing any signs of undue hardship.

In view of the foregoing comments, the Examiner is respectfully requested to again reconsider his position and to again act on the merits of all the claims.

Notwithstanding the clear propriety of the restriction requirement, in order to be fully responsive, Applicants provisionally elect compound claims 1 - 8 and 11 - 12 for prosecution in this application without prejudice to their right to petition the Commissioner to overturn the restriction requirement, and to their right to file a divisional application covering the process of the instant invention.

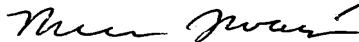
Further, in order to be fully responsive, in response to the requirement for an election of species, Applicants provisionally elect the species of claim 2 without prejudice to their right to file divisional applications. Applicants point out, however, that since they have an allowable generic claim in this case, they are entitled to claim a reasonable number of species within the genus. Furthermore, since all the species are so closely related, it is respectfully submitted that they can, and should, all be examined at the same time. In any event,

the claims directly readable on the provisionally elected species are claims 1 and 2.

It is also submitted that the amendments to the specification were made to clarify and correct typographical and grammatical errors.

Respectfully submitted,

BURGESS RYAN AND WAYNE


Milton J. Wayne, Reg.17906
370 Lexington Avenue
New York, New York 10017
(212) 683-8150

MJW/H/r